

REMARKS

In the Office Action, Claims 1-7 and 10-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,454,104 to Steidlmayer et al. in view of U.S. Patent No. 6,477,647 to Venkatraman et al.

1. **Establishing Prima Facie Obviousness Requires a Showing that the Skilled Artisan, Confronted with the Same Problems as the Inventor and With No Knowledge of the Claimed Invention, Would Select the Elements From the Cited Prior Art**

The Federal Circuit has set forth guidelines for establishing a prima facie case of obviousness under 35 U.S.C. §103.

"It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination."
Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985).

As such, the Federal Circuit set forth the particular burden, which the examiner must show in order to establish a prima facie case of obviousness as follows:

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the

inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) [emphasis added]; See Also, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 U.S.P.Q.2d 1315 (Fed. Cir. 1998).

2. **The Office Action Fails to Establish a Prima Facie Case of Obviousness because the References Do Not Teach an Automated Method of Communicating Trade Orders to a Marketplace for Financial Instruments through an On-line Trading Account with a Financial Institution.**

In the present case, Applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness, which comports to the principles as set forth in the Federal Circuit's case law opinions as discussed above. The particular reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed have not been identified in the Office Action.

The argument set forth in the Office Action in support of establishing a prima facie case of obviousness is as follows:

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically communicate through the use of a computer, a trade order based upon the trade decision to the marketplace via the on-line trading account and to modify in Steidlmayer because such a modification would allow Steidlmayer to receive a response through the computer and to execute the response according to the trade decision." (Office Action, pg. 3, *emphasis added*).

In this regard, the Office Action has merely indicated the benefit of Applicant's invention that Applicant has revealed in the Application itself. Stated otherwise, the Office Action in setting forth the reasoning for a motivation to combine the prior art references has merely utilized Applicant's disclosure as a roadmap to attempt to establish a case of obviousness. This is the exact "hindsight" type of reasoning that the Federal Circuit has sought to avoid.

Thus, the Office Action is silent with respect to why one skilled in the art would be motivated to combine the use of a computer to communicate a trade order based upon a trade decision to the market place via the on-line trading account without hindsight reference to Applicant's invention.

A. Brief Summary of Applicants Invention

The independent claims relate to an automated method or system for communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution. The method or system includes receiving trade trigger criteria for use by market analysis software. In addition, the market analysis software is configured to electrically receive market data. A trade decision is subsequently generated by the market analysis software in response to the trade trigger criteria being met by changes in the market data, where the market data is independent of the trade decision. Finally, a trade order based on the trade decision is automatically communicated to the marketplace via an on-line trading account.

The specification of Applicant's invention describes some of the efficiencies as follows:

"As such, based on the foregoing, the present invention mitigates the inefficiencies and limitations associated with prior art methods and systems for facilitating trading order entry activity. The present invention provides the user with efficiencies on many different levels due to its automated nature. First, unlike the typical computerized prior art systems, the user/trader is not required to physically enter a trade order by manually making keystrokes and/or computer mouse clicks to effect the desired trade. Second, the system is configured to automatically convert the trade decision to a trade order and immediately transmit it to the marketplace for execution. This avoids time delays between the trade decision and the trade execution which may be caused by lapses in trader attention. Avoidance of such delays which occur under the prior art when the trader is not immediately available to transmit the triggered trade order, mitigates against undesirable results due to adverse market price changes which may occur during such delays. Further, by automating the entry of the trade orders, the present invention provides a fail-safe substitute for the trader self-discipline necessary under the prior art for executing trading decisions in accordance with the user/trader's own pre-defined trading plan. It is noted, however, that the system may still be configured to allow for user intervention." (Specification, pgs. 6-7, para. 14).

Additional efficiencies and advantages of Applicant's invention are set forth in the specification at pages 6 to 7, paragraphs 14 and 15.

B. The Steidlmayer et al. and Venkatraman et al. References

The Steidlmayer et al. reference relates to a visual display of data from data inputted by a user. The user inputs various data into a personal computer or other stand-alone device.

The user designates a specific segment of displayed data, the specific study to be performed, and the study parameters to be inputted into the system. The visual display outputted allows the user to draw analytical conclusions about the data inputted. Hence, the Steidlmayer et al. reference contemplates a user making an informed trade decision by relying on the visual output of data inputted into the system.

The Venkatraman et al. reference teaches a method for confirming trade transactions via the Internet and/or private network to e-mail addresses. The invention contemplates a method for sending a confirming e-mail to a person that successfully traded with an on-line trading company.

The Steidlmayer et al. and Venkatraman et al. references are silent with respect to the aspect of Applicant's invention that relates to an automated method of communicating trade orders to a marketplace. Venkatraman et al. teaches a method for automatically confirming a trade order via e-mail, but does not teach a method of automatically making a trade decision and then transmitting the trade order through an on-line trading account. Steidlmayer et al. teaches a method for converting data into a visual display of data segments to assist the user in making an informed trade decision. Furthermore, the Applicant's specification describes the market analysis software capable of responding to changes in the market that cause the trade trigger criteria to be met, by outputting a trade decision. (Specification pg. 5, para. 11). Therefore, neither Steidlmayer et al. nor Venkatraman et al. teach or suggest "an automated method of communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution," as required by independent Claims 1, 10, and 19.

3. The Office Action Lacks Motivation to Combine the Steidlmayer et al. and Venkatraman et al. References in Making an Obviousness Rejection.

Without using Applicant's invention as a "blueprint", it remains unclear as to the motivation of combining the Steidlmayer et al. reference with making an automatic communication using a computer. The objective taught by the Steidlmayer et al. reference is to provide a system user with means to conduct studies through the system display of data segments. (See col. 4, lines 42-67). In other words, the Steidlmayer et al. invention contemplates providing the user with a visual display to enable the user to come to a trade decision. It is improper to combine the Steidlmayer et al. reference with the Venkatraman et al. reference because the stated purpose of the invention disclosed by the Steidlmayer et al. reference would be defeated by the suggested combination. Therefore, combining the Steidlmayer et al. reference with making an automatic communication using a computer would defeat the purpose of a user visually studying the display to make a calculated trade decision.

Applicant's invention as recited in Claim 1 includes "receiving through the use of a computer, trade trigger criteria for use by market analysis software, the market analysis software being configured to electrically receive market data." This aspect of the invention does not require a user to input data. The Steidlmayer et al. reference requires the user to select the information to be used by the software before the visual display can be outputted. Additionally Claim 1 recites, "accessing, through the use of a computer, the market analysis software to analyze the market data and generate a trade decision in response to the trade trigger criteria being met by changes in the market data, the market data being independent of the trade decision." This aspect of the invention contemplates analyzing the market data and

making a trade decision in response to trade trigger criteria being met. Steidlmayer et al. does not teach making a trade decision based on the market data inputted, rather it teaches outputting a visual display to help a user come to a trade decision. Another aspect of Applicant's invention as recited in Claim 1 includes "automatically communicating, through the use of a computer, a trade order based upon the trade decision to the marketplace via the on-line trading account." This aspect of Applicant's invention contemplates transmitting a trade order without requiring the user to be present. The trade order is made based on the trade decision made by the market analysis software. The Venkatraman et al. reference sends a confirming email when a trade order is made, but the reference does not teach making a trade order without requiring the user's presence.

Applicant's invention relates to market analysis software that receives market data and based upon the market data the software automatically makes a trade decision and places a trade order. Hence, there is no need for a person to analyze data on a visual display because a trade decision is made without requiring analysis by a user. Furthermore, it is not necessary to receive a confirming trade transaction, because the user of Applicant's invention can rely on the software to make trade decisions. Therefore, it may not be necessary to confirm a mouse click or keystroke entry.

Applicant's invention is advantageous because the user/trader is not required to enter a trade order by manually typing and/or computer mouse clicks to transmit the desired trade. Additionally, the system is configured to make a trade decision when a trade trigger criteria is met. This allows immediate trade orders to be transmitted to the marketplace for execution and avoids time delays between the trade decision and the trade execution due to trader inattention or absence.

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On the basis of the foregoing, Applicant therefore submits that each basis for rejection has been fully addressed, and therefore the Application is in condition for allowance.

Should the Examiner have any suggestions for expediting allowance of the Application, the Examiner is invited to contact Applicant's representative at the telephone number listed below.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

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